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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,641	01/23/2001	Kazuhiko Sakata	072982/0215	4289
22428	7590	05/04/2005	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			GYORFI, THOMAS A	
			ART UNIT	PAPER NUMBER
			2135	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/766,641	SAKATA, KAZUHIRO	
	Examiner	Art Unit	
	Tom Gyorfi	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 January 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-45 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-45 remain for examination. The correspondence filed 1/12/05 did not amend, add, or cancel any claims.

Response to Arguments

2. Applicant's arguments filed 1/12/05 have been fully considered but they are not persuasive.

Applicant argues, "*Neither Zabetian nor Smith, alone or in combination, disclose or suggest the document publication system including the above-quoted features where document data is published by use of a public medium, the publication time of the document data is recorded, and the publication time can later be verified upon request.*" Examiner disagrees with this contention. Smith teaches that the publishing server contains information about the digital documents to be published, including a creation date (col. 4, lines 40-45). Since the server disclosed by Smith is construed to publish the document in question immediately upon its receipt of the document (col. 2, lines 20-25), and that the creation date would reflect the date on which the file was created on the server (as is typically done by prior art file systems; the store disclosed by Smith in col. 4, lines 25-50 is clearly analogous), then at the minimum the suggestion exists for the creation date to be equivalent to the publication date of the document in question.

Applicant further argues, "*However, there is no motivation in Zabetian to combine the system in Zabetian with the system of Smith, because Zabetian is not worried about proof of publication time, but rather about proof of certification time. (Zabetian; abstract', column 2, lines 12-15). In fact, the examples provided in Zabetian demonstrate that the system in Zabetian was predicated on the idea that*

the documents to be certified would not be published." The relevant portion of the Zabetian disclosure (col. 14, lines 35-52) was then quoted:

There are various application for electronic document certification. A non-exhaustive list of suggestions follows. A scientist draws up a draft of a patent. Before showing this patent to any potential investors, she can submit an electronic document including her work for certification. She is then provided with an identification code (possibly including a copy of the document and time and date information). If this scientist ever wished to prove when she had created her artwork, she can use the identification code and a copy of the document to authenticate the document and to prove when she had possession. A screenwriter has an idea regarding a new motion picture. He is uneasy about approaching motion picture companies with the idea before protecting himself. Therefore he will send an electronic mail enclosing his screenplay for certification. Similarly, a harassed employee can submit a written account of an event by electronic mail for certification; a musician recording a score on a computer can submit the document for certification. (Emphasis Examiner's)

Examiner contends that the example quoted above of a musician who wishes to certify one's work would do so with the intent to publish/distribute said work, as would be expected of a professional musician; further, a harassed employee would logically use any written account of an event perhaps as part of the pertinent legal proceedings, which would entail that said written account would be published as part of the public record of the case. Thus, the suggestion exists that one would be inclined to use the disclosure by Zabetian to certify documents intended for publication. Furthermore, Smith also teaches that security is a primary concern, noting that the publication system should protect against unauthorized access (Smith, col. 10, line 57 – col. 11, line 4).

Tampering a document falls within the domain of “unauthorized access”, which is precisely what the Zabetian disclosure is designed to protect (Zabetian, Abstract).

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-6, 8-11, 14-21, 23-26, 29-36, 38-41 and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zabetian (U.S. Patent 6,327,656) and further in view of Smith et al. (U.S. Patent 5,790,790).

Regarding claims 1-2, 16-17, and 31-32, Zabetian discloses a system for electronic document certification and verification, including the means for receiving document data (column 14, lines 61-66), data registration control means for recording the certification time of the received document (element 256 of Figure 2), and a certificate issuing means for verifying the certification time upon request (element 260 of Figure 2). Zabetian does not teach that the documents it processes are published. However, Smith discloses a system to deliver electronic documents to one or more recipients that comprises at least one server that transmits documents submitted by users (Smith, column 2, lines 20-31 and elements 12[a-n] of Figures 1 and 2). This act constitutes “publishing” under the broadest possible definition of the term. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention disclosed by Zabetian to publish copies of a document to be certified to one or more recipients in addition to the original user, if the user so

chose. It would be faster and more convenient, as the user would not have to wait for a response from the certifying server before manually sending the time-stamped document back into the public network for publication.

Regarding claims 3-6, 18-21, and 33-36, Zabetian discloses that a digital signature is created from the submitted document [claims 3, 18, and 33], and that the certificate, along with the date of certification [claims 4, 19, and 33] and a serial number [claims 5-6, 20-21, and 35-36], are all provided to the user (Zabetian, column 12, lines 49-58).

Regarding claims 8-10, 23-25, and 38-40, Zabetian teaches that a client can be connected to the server by the Internet, which was well known as a public network (Zabetian, column 3, lines 57-63). Examiner takes Official Notice that the Internet is a form of mass media, evidenced by the ever-increasing amount of web pages and assorted interactive content that was available even at the time the invention was made.

Regarding claims 11, 26, and 41, note that the invention of Zabetian as modified by Smith above would allow for the delivery of documents from one end-point to a multitude of endpoints (Smith, column 3, lines 47-49). This constitutes “broadcasting” under the broadest definition of the term.

Regarding claims 14, 29, and 44, Zabetian teaches that a client emails a document to be certified over the Internet (Zabetian, column 2, lines 1-2 and also column 6, lines 21-22).

Regarding claims 15, 30, and 45, Smith teaches a reporting mechanism that can provide a full report of a given transaction, including information on who received a

given document (Smith, column 11, lines 46-52). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a reporting mechanism such as the one disclosed by Smith into the invention disclosed by Zabetian. Maintaining access logs and supplying reports based on said access logs would be beneficial for statistical purposes, such as keeping track of which documents were the most popular (e.g., most often verified) on a given server.

5. Claims 7, 22, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Zabetian and Smith as applied to claims 2, 17, and 32 above, and further in view of RFC 1521 ("MIME (Multipurpose Internet Mail Extensions): Mechanisms for Specifying and Describing the Format of Internet Message Bodies").

Neither Zabetian nor Smith explicitly teach that the documents processed by their respective inventions have the format altered when the format of the document data is not in a predetermined format. However, it should be noted that Zabetian allows a user to submit a document for certification by sending it through email (Zabetian, column 6, lines 21-22; column 7, lines 19-21). Email, as sent over the Internet, adhered to the standards laid out in the RFC documents cited here and elsewhere in this Action; this remains true even today. Of particular relevance is the fact that various types of binary data to be sent over email are encoded into a format known as Base64 encoding so as to be compatible with existing email systems (RFC 1521, "Introduction" pg.3, 2nd paragraph; and also "Base64 Content-Transfer-Encoding" pp. 21-22). Given that standards-based email is a component of the invention disclosed by Zabetian (column

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5, lines 41-43), that Smith teaches that binary files are valid documents that can be published by that system (Smith, column 3, lines 47-51), and that the server would be required to convert any incoming documents from base64 encoding to a predetermined format (RFC 1521, Appendix A, pg. 60, "Recognize the Content-Transfer-Encoding..."), it can thus be argued that Zabetian as modified by Smith contains the limitation recited in these claims. Even were that not so, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include this feature, as this method allows for documents in other formats besides ASCII text to be submitted for digital signing and time-stamping.

6. Claims 12, 27, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zabetian and Smith as applied to claims 10, 25 and 40 above, and further in view of LaMarca et al. (U.S. Patent 6,279,013).

Neither Zabetian nor Smith teach that the published document can be output as a newspaper. However, LaMarca discloses an interactive newspaper that is composed on a computer and then printed out for a user (LaMarca, column 4, lines 41-45; and also column 5, lines 8-11). Furthermore, it should be noted that the invention disclosed by Smith allows for published documents to be printed on a printer (Smith, column 3, lines 47-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to print documents that have been time-stamped by the combination of Zabetian and Smith either as a part or as the whole of a newspaper, as taught by LaMarca. By providing hard copies of documents, people who do not have

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convenient access to a computer will still be able to make use of them; furthermore, newspapers were well known to those of ordinary skill in the art as a common and popular means of disseminating information.

7. Claims 13, 28, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zabetian and Smith as applied to claims 2, 17, and 32 above, and further in view of Rivette et al. (U.S. Patent 5,623,679).

Both Zabetian and Smith are silent regarding the potential content of any document to be processed by their respective systems. Consider the patent documents issued by this Office; by definition, a patent describes an idea or invention created by one or more inventors (persons) for the purposes of establishing the right of exclusive use of said idea or invention for a limited time, and that such documents must by necessity be available to the public. Furthermore, it was well known at the time of the invention disclosed by Applicant that patent documents could be processed and displayed electronically (Rivette, column 2, lines 54-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to expressly permit patent documents as a valid type of document to be processed by the invention disclosed by Zabetian in view of Smith. One would be motivated to do so because any second-hand copy of a patent document might have been altered during its lifetime; by stamping the publication time and digital signature on an electronic copy and comparing the stamp against the plaintext date already included on the patent document, one can more easily detect any unauthorized modifications to that copy.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Gyorfi whose telephone number is (571) 272-3849. The examiner can normally be reached on 8:00am - 4:30pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



KIM VU
SUPPLEMENTARY PATENT EXAMINER
TECHNOLOGY CENTER 2100